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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, ~~1949~~ 1950

No. ~~686~~ 32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
Petitioner,

vs.

SUPERMARKET EQUIPMENT CORPORATION, SUBSTITUTED FOR EVELYN B. BRADLEY AND JOE WEINGARTEN

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI

Petitioner, The Great Atlantic & Pacific Tea Company, prays that a writ of certiorari issue to review the judgment of the Circuit Court of Appeals for the Sixth Circuit (R. 591) affirming the decision of the United States District Court for the Eastern District of Michigan, Southern Division (R. 564) by a divided court, one of the judges dissenting. A petition for rehearing was denied, again with the dissent of Judge Martin.

Opinions Below

The findings of fact and conclusions of law and the opinion of the District Court appear in the record on pages 564 to 581. The opinion of the Circuit Court of Appeals appears in the record on pages 592 to 599.

Jurisdiction

The jurisdiction of this Court is invoked under C646, 62 Stat. 928, 28 U. S. C. A. 1245, of the Act of June 25, 1948. The judgment of the Circuit Court of Appeals, which the petitioner here seeks reviewed, is dated January 17, 1950, and the order denying the petition for rehearing is dated February 10, 1950. The petition is, therefore, timely.

Questions Presented

1. May a court imply as elements of a patent claim parts not named therein for the purpose of limiting its scope so that it may be accorded novelty?

2. May a patentee rely upon an element of limitation to establish validity which is not particularly pointed out nor distinctly claimed?

3. Where the courts below did not pass on the separate claims in issue but found invention in a combination of elements not embraced in any single claim, does the affirmance by the Court of Appeals of the judgment of the District Court constitute concurrent findings?

4. Can a patentee withdraw the broad claims of its patent over the objection of the defendant without disclaiming and choose to rely only upon narrow claims?

Statutes Involved

The questions here presented involve the construction of the patent law and more particularly one section thereof, R. S. 4886, 35 U. S. C. 31, the relevant portions thereof being as follows:

"R. S. 4886—Inventions Patentable.

"Any person who has invented * * * any new and useful art, machine, or composition of matter, or

any new and useful improvement thereof * * * not patented or described in any printed publication in this or any foreign country * * * may * * * obtain a patent therefor."

Also involved is the disclaimer statute R. S. 4917.

"R. S. 4917—Disclaimer.

"* * * and any such patentee, his heirs or his assigns * * * may * * * make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent * * * but in every case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit."

Statement

This is an action involving the infringement of United States Letters Patent No. 2,242,408 issued to Joe Weingarten, as the assignee of Ellis D. Turnham, for a merchandise handler, sometimes referred to as a counter-pusher. The charge of infringement is based upon the use by the defendant of a three-sided bottomless rack on its checkout counters to pull the merchandise of a customer up to the checker. The patent contained six claims, three of which—1, 2 and 3—were withdrawn from the action over the defendant's objection. At the trial it was conceded that the claims in suit would be infringed if the patent were valid. The patent in suit appears in the record at page 370, and a photograph of the alleged infringing device at page 334. The claims in issue are claims 4, 5 and 6 which read as follows:

"4. A checker's stand including a counter of the character described, an open bottom pusher frame

thereon, means to guide said frame in sliding movement so that goods placed on the end of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker by movement of said frame.

"5. A cashier's counter for cash and carry type of grocery comprising a portion spaced from the cashier's stand and upon which the merchandise may be deposited and arranged, a bottomless three sided frame on said portion and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from said portion to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier.

"6. A cashier's counter for cash and carry type of grocery comprising a portion spaced from the cashier's stand and upon which the merchandise may be deposited and arranged, a bottomless frame on said portion and within which the merchandise is deposited and arranged, means whereby said frame is movable on said counter from said portion to a position adjacent the casher's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier, said frame being open at the end adjacent the cashier's stand and readily movable to be returned over said portion so as to receive the merchandise of another customer while the cashier is occupied with the previous group."

The District Court in its opinion (pages 568-569) stated:

"The bottomless tray is not novel, as note, for example, the well known pool rack. Neither is a checking-out counter nor the use of guide rails. These have been seen in self-serve restaurants for years. However, the extension of the checking-out counter was apparently something new, as it automatically placed the register farther up on the checking-out aisle, and

the use of the bottomless tray on that extension, self-unloading its contents right in front of the cashier, was decidedly a novel feature.'"

The majority opinion of the Circuit Court of Appeals quoted with approval the District Court finding 15:

"'15. Claims 4, 5 and 6 of the patent in suit define a new combination of elements brought together for the first time by Turnham to provide an improved checkout counter.

"'Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention. Also checking-out counters were known. Moreover, guide rails for trays had been used in self-serve restaurants.

"'However, the conception of a counter with an extension to receive a bottomless self-unloading tray with which to push the contents of the tray in front of the cashier was a decidedly novel feature and constitutes a new and useful combination.'"

The District Court allowed the respondent to withdraw claims 1, 2 and 3 and the Circuit Court of Appeals held in the majority opinion that the District Court did not err in refusing to pass on the validity of these claims.

Specification of Errors to Be Urged

The Circuit Court of Appeals erred:

1. In adapting as an element of the claims in suit the extension to the checkout counter which was not an element of the claims in order to find a novel combination.

2. In finding that the adaptation of a three-sided bottomless rack, old in the art, to a checkout counter constituted invention.

3. In affirming the District Court's action in allowing plaintiff to withdraw his broader claims—claims 1, 2 and 3—from suit and refusing to pass on the validity thereof.

4. In not holding that the Turnham contribution was a mere expedient not rising to the dignity of invention.

5. In affirming by a divided court the decision of the District Court.

6. In denying the petition for rehearing.

Reasons for Granting the Writ

1. The decision of the Circuit Court of Appeals affirming by a divided court the District Court is in direct conflict with the applicable decisions of this Court.

2. The action of the courts below in reading into the claims an element not contained therein is in direct conflict with the applicable decisions of this Court.

3. The decision of the courts below affects a large portion of the supermarket industry and will affect litigation now pending in other circuits against other users of devices similar to defendant's.

WHEREFORE, it is respectfully submitted that this petition should be granted.

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
By JOHN H. GLACCUM,
Attorney for Petitioner.

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BRIEF IN SUPPORT OF WRIT OF CERTIORARI

Statement

The opinion below, jurisdiction, the questions presented, statutes involved and the specifications of errors are stated in the petition.

The patent involved purports to cover a three-sided bottomless rack adapted to be placed on the checkout counter of a grocery supermarket. Guides are provided which prevent the rack from falling off the counter. A photograph of one of defendant's checkout counters appears in the record at page 360. The purpose of the device is to permit one customer to unload his bascart on the counter while the cashier is checking out the previous customer. The cashier may then pull the second customer's purchases up to

the cash register by sliding the rack down the counter to a position in front of him. He then returns the rack for the next customer. The patent (R. P. 370) shows a somewhat more complicated device, but what is claimed is essentially a three sided bottomless rack placed on the conventional checkout counter.

Summary of Argument

1. The courts below based the finding of invention on a combination of elements not set forth in the claims in suit.

2. The Turnham patent in suit does not involve invention.

3. It was error to allow the plaintiff to withdraw the broadest claims from the suit.

Argument

1. The courts below based the finding of invention on a combination of elements not set forth in the claims in suit.

The District Court and the majority opinion of the Circuit Court of Appeals found that novelty and invention reside in a combination of three elements: 1) a checkout counter; 2) an extension on the checkout counter; 3) a three-sided rack.

This is obvious from the District Court's opinion (R. P. 568-569) wherein Judge Picard stated:

> "The bottomless tray is not novel, as note, for example, the well known pool rack. Neither is a checking-out counter nor the use of guide rails. These have been seen in self-serve restaurants for years. However, the extension of the checking-out counter was apparently something new, as it automatically placed the register farther up on the checking-out aisle, and the use of the bottomless tray on that extension, self-unloading its contents right in front of the cashier, was decidedly a novel feature."

The majority opinion (R. 594-5) quoted with approval finding 15:

> "'15. Claims 4, 5 and 6 of the patent in suit define a new combination of elements brought together for the first time by Turnham to provide an improved check-out counter.
>
> "'Three-sided bottomless racks or trays had been used in racking pool balls prior to the Turnham invention. Also checking-out counters were known. Moreover, guide rails for trays had been used in self-serve restaurants.
>
> "'However, the conception of a counter with an extension to receive a bottomless self-unloading tray with which to push the contents of the tray in front of the cashier was a decidedly novel feature and constitutes a new and useful combination.'"

An examination of the claims in suit makes it clear that the extension was not set forth nor claimed. Claim 4, for instance, reads as follows:

> "4. A checker's stand including a counter of the character described, an open bottom pusher frame thereon, means to guide said frame in sliding movement so that goods placed on the end of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker by movement of said frame."

The only structure specifically defined in said claim is "A checker's stand including a counter", which is admittedly old, and "an open bottom pusher frame". These elements the courts found to be old. They did, however, base the finding of invention on the combination of these elements with an extension on the checkout counter. Circuit Judge Martin recognized that the extension of the counter was not claimed in claims 4, 5 and 6, and in his dissenting opinion stated:

> "I am unable to find invention in the patent claims in suit. It seems to me that the combination of the admittedly old elements as described in the claims does not rise to the dignity of invention, and that the findings of fact of the district court are clearly erroneous."

It is well settled law that every element and limitation relied upon to establish the validity of a claim must be particularly pointed out and distinctly claimed.

Walker on Patents (p. 770) summarizes the function of a patent claim as follows:

> "It is the claims of a patent which 'measure the invention,' and which 'apprise the public of what is still left open to them.' (Paper Bag Pt. Case, 210 U. S. 405, 409; U. S. L. & H. Corp. v. Safety Car H. & L. Co., 261 Fed. 915, 918, C. C. A. 2; Fulton Co. v. Powers Reg. Co., 263 Fed. 578, 580, C. C. A. 2; Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 61 L. Ed. 871, 876). A claim is not 'like a nose of wax which may be turned and twisted in any direction,' so as to make it include something more than, or something different from, what its words express, by merely referring to the specification. The claims are the creature of statute in which the inventor is required to particularly point out and distinctly claim his invention. (White v. Dunbar, 119 U. S. 47, 51.)"

As long ago as 1895 this Court held that a feature may not be read into a claim for the purpose of sustaining a patent. In *McCarty* v. *Railroad Co.* (160 U. S. 110, 116, 40 L. Ed. 358, 361), Mr. Justice Brown writing for this Court stated:

> "There is no suggestion in either of these claims that the ends of the bolster rests upon springs in the side trusses, although they are described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in

which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim, and avoid a defense of anticipation, we should never know where to stop. If, for example, a prior device were produced exhibiting the combination of these claims plus the springs, the patentee might insist upon reading some other element into the claims, such, for instance, as the side frames and all the other operative portions of the mechanism constituting the car truck to prove that the prior device was not an anticipation. It might also require us to read into the fourth claim the flanges and pillars described in the third. This doctrine is too obviously untenable to require argument."

The foregoing case has been cited with approval consistently through the years, and more recently the same principle was set forth in the case of *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corporation* (294 U. S. 477, 79 L. Ed. 1005). There the Court stated, at page 487:

"The Court of Appeals, in upholding the patent, made no examination of its separate claims, but treated the patent throughout as though it were a combination of five distinct elements, the photoelectric cell, the arcuate flexing of the film, the flywheel, the flexible connection of the flywheel and the optical slit, although nowhere in the patent is any such combination claimed. The patent thus upheld is one which was neither claimed nor granted. Under the statute it is the claims of the patent which define the invention. See White v. Dunbar, 119 U. S. 47, 51, 52, 30 L. Ed. 303, 304, 305, 7 S. Ct. 72; McClain v. Ortmayer, 141 U. S. 419, 423-425, 35 L. Ed. 800, 802, 803, 12 S. Ct. 76; Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 419,

52 L. Ed. 1122, 1128, 28 S. Ct. 748; Smith v. Snow, decided January 7, 1935 (294 U. S. 1, ante, 721, 55 S. Ct. 279). And each claim must stand or fall, as itself sufficiently defining invention, independently of the others. See Carlton v. Bokee, 17 Wall. 463, 472, 21 L. Ed. 517, 519; Russell v. Place, 94 U. S. 606, 609, 24 L. Ed. 214, 215; Leeds & C. Co. v. Victor Talking Mach. Co., 213, U. S. 301, 319, 53 L. Ed. 805, 813, 29 S. Ct. 495; T. H. Symington Co. v. National Malleable Castings Co., 250 U. S. 383, 385, 63 L. Ed. 1045, 1048, 39 S. Ct. 542; Smith v. Snow (294 U. S. 1, ante, 721, 55 S. Ct. 279), supra; Walker, Patents, 6th ed. § 220. As none of the flywheel claims as drawn define an invention, none can be aided by reading into it parts of the specifications, or of other claims, which the patentees failed to include in it."

The foregoing case also stands for the proposition that where the Court of Appeals does not pass on the separate claims in issue but finds invention in a combination of elements not embraced in any single claim, the case presents no question of concurrent findings by the courts below that the claims in issue involved invention.

2. The Turnham patent in suit does not involve invention.

It is submitted that the dissenting opinion below is obviously correct in finding a lack of invention in the claims in suit. All that Turnham did was to apply a three-sided bottomless rack shown in the Varnum patent (R. P. 180) to the existing checkout counter. This does not rise to the dignity of invention but is merely an expedient of one skilled in the art. *Cuno Engineering Corporation* v. *Automatic Devices Corporation* (314 U. S. 84, 80 L. Ed. 58). At page 90 of the U. S. Report, Mr. Justice Douglas writing for the court stated:

"We may concede that the functions performed by Meade's combination were new and useful. But that does not necessarily make the device patentable. Under

the statute (35 U. S. C. A., § 4886) the device must not only be 'new and useful', it must also be an 'invention' or 'discovery'. Thompson v. Boisselier, 114 U. S. 1, 11, 29 L. Ed. 76, 5 S. Ct. 1042. Since Hotchkiss v. Greenwood, 11 How. (U. S.) 248, 267, 13 L. Ed. 683, 691, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. Hicks v. Kelsey, 18 Wall (U. S.), 670, 21 L. Ed. 852; Slawson v. Grand Street, P. P. & F. R. Co., 107 U. S. 649, 27 L. Ed. 576, 2 S. Ct. 663; Phillips v. Detroit, 111 U. S. 604, 28 L. Ed. 532, 4 S. Ct. 580; Morris v. McMillin, 112 U. S. 244, 28 L. Ed. 702, 5 S. Ct. 218; Saranac Automatic Mach. Corp. v. Wirebounds Patents Co., 282 U. S. 704, 75 L. Ed. 634, 51 S. Ct. 232; Honolulu Oil Corp. v. Halliburton, 306 U. S. 550, 83 L. Ed. 980, 59 S. Ct. 662. 'Perfection of workmanship, however much it may increase the convenience, extend the use, or diminish expense, is not patentable'. Reckendorfer v. Faber, 92 U. S. 347, 356, 357, 23 L. Ed. 719, 723, 724. The principle of the Hotchkiss case applies to the adaptation or combination of old or well-known devices for new uses. Phillips v. Detroit, 111 U. S. 604, 28 L. Ed. 532, 4 S. Ct. 580, supra; Concrete Appliances Co. v. Gomery, 269 U. S. 177, 70 L. Ed. 222, 46 S. Ct. 42, supra; Powers-Kennedy Contracting Corp. v. Concrete Mixing & Conveying Co., 282 U. S. 175, 75 L. Ed. 278, 51 S. Ct. 95, supra; Electric Cable Joint Co. v. Brooklyn Edison Co., 292 U. S. 69, 78 L. Ed. 1131, 54 S. Ct. 586; Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477, L. Ed. 1005, 55 S. Ct. 455, supra; Textile Mach. Works v. Louis Hirsch Textile Machines, 302 U. S. 490, 82 L. Ed. 382, 58 S. Ct. 291; Toledo Pressed Steel Co. v. Standard Parts, 307 U. S. 350, 83 L. Ed. 1334, 59 S. Ct. 897. That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain. * * *"

3. It was error to allow the plaintiff to withdraw the broadest claims from the suit.

The complaint as filed (R. P. 2) alleged infringement of the Turnham patent No. 2,242,408 without any restriction as to the claims involved. At the trial plaintiff, over defendant's objection (R. P. 214) withdrew claims 1, 2 and 3 but has filed no disclaimer of these claims.

Claim 2 reads as follows:

> "[A cashier's counter in a cash and carry type of grocery, a cashier station, a portion on the counter to receive the merchandise being purchased, and means slidable on the surface of the counter to enclose and move such merchandise to the cashier station."

This claim is obviously broader than claims 4, 5 and 6 and would, in fact, be infringed and likewise anticipated by sliding a basket along the top of a counter in the same way that baskets have been slid along checkout counters for years.

It is submitted that where a claim is challenged as to its validity the patentee is under a duty either to disclaim the claim or, where he has the opportunity, to litigate. The patentee had the opportunity here to litigate but rejected the opportunity and neglected to disclaim. The law is clear that where a claim is held invalid it must be either disclaimed or be litigated promptly. *Ensten* v. *Simon Ascher & Co.* (282 U. S. 445, 75 L. Ed. 453). In the present suit had the court held claims 4, 5 and 6 invalid, the patentee would have been in a position to bring a new action against another defendant under claims 1, 2 and 3. Defendant had a right to an adjudication of claims 1, 2 and 3 since, if they should have been disclaimed, the failure to so disclaim would affect the question of costs (R. S. 4922, 35 U. S. C. 71).

It is submitted that the courts below should have adjudicated the entire patent and not allowed the patentee to withdraw obviously invalid claims without disclaiming them.

Conclusion

WHEREFORE, it is respectfully submitted that this petition for writ of certiorari should be granted.

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